

## **REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1, 2 and 4-20 are now pending in this application. It is believed that no new matter has been added. The applicants reserve the right to file a continuing application to further prosecute the scope of the originally filed claims.

[Reference to the specification in this response is made via the page and paragraph numbers from U.S. Patent Application Publication 2004-0198842]

### **II. THE DOUBLE PATENTING REJECTION HAS BEEN OVERCOME**

Claim 16 has been amended to incorporate language which indicates that R<sup>2</sup> is R<sup>3</sup>. As such claim 16 is no longer a duplicate of claim 7, i.e. in claim 7, where R<sup>2</sup> could still be R<sup>3</sup>, R<sup>4</sup> or R<sup>5</sup> (albeit with a narrower scope for R<sup>3</sup> than described in claim 1), for claim 16, R<sup>2</sup> can only be the R<sup>3</sup> as defined in the claim.

### **III. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTIONS HAVE BEEN OVERCOME**

Claims 1, 2 and 4-20 were rejected as allegedly failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Each of these rejections is addressed below:

(1) In order to advance prosecution, the temperature for the viscosity is defined in paragraph [0036] of the specification. As previously noted, in the absence of temperature designations, room temperature is presumed for viscosity (e.g. the Schulz reference used in the 102/103 rejection below did not specify a temperature for their viscosity).

(2) With regard to the intent of the transitional language "consisting of", in order to expedite prosecution, the non-transitional language "which is" has been used as a substitute. As there appears to be some confusion with regard to the nature of the invention ("It is unclear that the 'aqueous defoamer emulsion' and the 'oil-in-water' emulsion can exist as distinct emulsions"???), the applicants would like to take the opportunity to explain the invention.

The aqueous defoamer emulsion is an emulsion which comprises of at least two components, i.e. A) at least one active defoaming substance and B) an oil-in-water emulsion. The components are not intended to exist as distinct components (by analogy a saline solution

comprising of water and a solid metallic salt does not exist as separate components in solution). The use of "comprising" after aqueous defoamer emulsion is intended to indicate that other components may be added as long as the invention still exists as an aqueous defoamer emulsion, the use of "consisting" was intended to define distinct boundaries for one of the components which made up the aqueous defoamer emulsion.

(3) With regard to claims 7-9 and 16-18, selected text from the claims has been deleted to avoid any confusion between "comprising" and "consisting of" language.

(4) With regard to the possibility of R<sup>1</sup> and R<sup>2</sup> possibly being the same, the applicants acknowledge this possibility, but are unclear why this has any bearing on one of ordinary skill in the art being able to select the appropriate value for the scope of "a" and "b" as opposed to R<sup>2</sup> being any other possibility defined by variables R<sup>3</sup>, R<sup>4</sup> and R<sup>5</sup>.

(5) With regard to the metes and bounds of the phrase "at least one active defoaming substance", one of ordinary skill in the art would be able to determine whether a compound was categorized or recognized to have defoaming properties in general.

While the remainder of the rejection appears to be directed more towards a lack of enablement for the full scope of the invention, the applicants also address this portion of the office action as follows.

With the amendment to the claim that the emulsion of the invention provides defoaming action in a cooling lubricant, it is noted that three known defoamers (component (A) - Defoamers 1, 2 and 3 as described in the table of [0065]) had no defoaming effect against a cooling lubricant. Likewise, three examples of the oil-in-water emulsion (component (B) - Emulsions 1, 2 and 3 in [0065]) also had no defoaming effect. It is only when (A) and (B) are added together that any defoaming effect is exhibited for a cooling lubricant. As the applicants have provided 9 examples of this effect, the burden shifts to the office as to why the full scope of the invention is not enabled.

**IV. THE 35 U.S.C. 102 and 103 REJECTIONS HAVE BEEN OVERCOME**

- (1) Claims 1, 2, 4, 5 and 7-20 were rejected as allegedly being anticipated by Dow Corning Toray Silicone Co., Ltd. (EP 761 724 - "Dow Corning").
- (2) Claims 11 and 12 were rejected as allegedly being obvious over Dow Corning Toray Silicone Co., Ltd. (EP 761 724 - "Dow Corning").
- (3) Claims 1-20 were rejected as allegedly being anticipated or in the alternative as allegedly being obvious over Schulz et al. (U.S. Patent 5,811,487 - "Schulz").

The applicants maintain their position from the previous response and add the following comments in light of the amendments to the claims.

Dow Corning does not anticipate or render obvious the applicants claimed invention as amended as the claims now require at least two discrete components, i.e. A) at least one active defoaming substance and B) an oil-in-water emulsion. Moreover, Dow Corning does not refer to the use of an emulsion or the use of an oil-in-water emulsion. As all of the claimed elements are not taught, the applicants' claims are not anticipated.

With regard to obviousness, as noted above, all of the claimed elements are not taught by Dow Corning. In addition, there is no teaching suggestion or motivation to add a defoamer to Dow Corning's formulation with respect to an emulsion for defoaming a cooling lubricant concentrate, i.e. the state of the art was such that the oil-in-water emulsions with organopolysiloxanes alone and a defoamer alone would have been thought to be ineffective to provide defoaming action for a cooling lubricant concentrate. There would have been no reasonable expectation of success that such a combination would have provided the results disclosed by the applicants. Therefore, the applicants' claims are not rendered obvious by Dow Corning.

The comments with regard to Dow Corning also apply to Schulz which is actually even further removed that Dow Corning which refers to paste-like formulations and are not considered to be emulsions.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
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